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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,578	06/29/2001	Miklos Sagi	367.40296X00	5598

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BANNER & WITCOFF, LTD.  
1100 13th STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20005-4051

EXAMINER

CHANKONG, DOHM

ART UNIT PAPER NUMBER

2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/893,578

Applicant(s)

SAGI, MIKLOS

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-24, 26, 27, 30, 33, 35, 37-42 and 44-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24, 26, 27, 30, 33, 35, 37-42 and 44-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

- 1> This action is in response to Applicant's remarks, filed 2.1.2007. Claims 17-24, 26, 27, 30, 33, 35, 37-42 and 44-48 are presented for further examination.
- 2> This is a final rejection.

#### *Response to Arguments*

- I. THE §112 REJECTION, FIRST PARAGRAPH REJECTIONS ARE MAINTAINED BECAUSE APPLICANT'S SPECIFICATION, INCLUDING THE CITED PORTION FAIL TO DESCRIBE THE CLAIMED SUBJECT MATTER OF CLAIM 45.

Applicant argues that the §112 rejection of claims 45-48 for failing to comply with the written requirement is improper. Applicant points to page 10, paragraph 1 of Applicant's specification for support of the disputed limitation. However this cited portion states, in relevant part, that when information is not yet received, "the device may operate as already described with reference to steps 506 onwards of Figure 5." Steps 506 onward do not discuss forming a list of items for which the selected further information has been received but excluding other items for which other information has not been received. Therefore, the §112 rejection is maintained.

- II. APPLICANT'S ARGUMENTS WITH RESPECT TO THE §103 REJECTIONS UNDER BLOUNT, SLOTZNICK AND SAKSENA ARE NOT PERSUASIVE.

Applicant attacks the §103(a) rejection of claims 18, 19, 22, 23, 26, 33, 35 and 37-39 arguing that the relied upon prior art are "internally incompatible" and therefore cannot be combined. Applicant argues in substance: (a) Blount and Slotznick are incompatible because Slotznick is directed towards primary and secondary information whereas Blount is merely

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directed towards primary information; (b) Slotznick does not disclose momentary display of the further information; (c) Saksena is incompatible because Saksena is directed towards a different connection method from Blount and Slotznick. The Office disagrees with Applicant's analysis of the prior art for the following reasons.

A. Slotznick's primary and secondary information functionality improves Blount.

Slotznick's primary and secondary information improves Blount's invention.

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. MPEP §2123(II). Prior art teach away from a combination if it "criticize(s), discredit(s), or otherwise discourage(s) the solution claimed." Id.

Applicant's argument amounts to a teaching away argument. Applicant notes that Blount is directed towards an invention that is criticized by Slotznick - Blount is directed towards a system with only primary information while Slotznick is directed towards a system with both primary and secondary information. This difference between prior art systems is simply Slotznick recognizing a deficiency in Blount's invention. Slotznick clearly is directed towards an improvement over Blount's reliance on only primary information. By categorizing the information into primary and secondary, various features can be introduced into Blount that would enable taking better advantage of interstitial space [Slotznick, column 4 «lines 31-34»].

B. Slotznick discloses the feature of momentarily displaying further information.

As understood by the Office, Applicant is simply arguing that Slotznick's momentary display of secondary data is not analogous to Applicant's claimed limitation of "momentary

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display of the further information (or an icon)." Applicant concedes that Slotznick discloses "momentary display of information." Beyond a conclusory statement that Slotznick is dissimilar, Applicant does not provide any arguments as to why Slotznick's disclosure of secondary data is different from "further information." As such, the Office maintains that Slotznick's disclosure of momentarily displaying secondary data is analogous to Applicant's claimed limitation.

C. Saksena does not confine his invention to constant connections.

Applicant argues that Saksena is directed to the problem of slow modem connections that are "constantly connected." It is first noted that Saksena does not expressly limit his invention to only those modem connections that are constantly connected; Applicant's strained argument is based solely on Saksena's discussion of "typical users" who are "based in their homes." Viewed more broadly and fairly, Saksena is directed towards "efficiently using...free bandwidth and enhancing perceived performance on the client" [column 1 «lines 11-13»]. Saksena accomplishes this goal by the principle of prefetching; Saksena does not limit this principle to only those connections that are "based in the homes" of users.

Rather, Saksena's disclosure is directed broadly towards a server-client system. One of ordinary skill in the art would have been able to implement Saksena's teachings of prefetching documents in other server-client systems, such as those taught in Blount and Slotznick. Saksena clearly discloses that the benefit of his invention is merely to improve "user perceived network performance and reducing the demand on the server and network" [column 2 «lines 26-29»]. Blount's client-server system would thus be improved by Saksena's teaching.

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III. BASED ON THE FOREGOING REMARKS, THE CLAIM REJECTIONS ARE MAINTAINED.

Thus, there is nothing in either Slotznick and Saksena that would have prohibited one of ordinary skill in the art to have combined their inventive principles into Blount to improve Blount's system. Saksena teaches a server-client system. Blount discloses a server-client system. One of ordinary skill in the art would have been motivated to modify Blount based on Saksena's express goal of improving network performance in other server-client systems.

Applicant's arguments with respect to the second to tenth rejections have been considered but they do not set forth any substantively new arguments that have not already been addressed with respect to the first rejection. Therefore, the foregoing remarks apply to Applicant's arguments with respect to these claims as well. The claim rejections are therefore maintained.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3> Claims 45-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Claim 45 discloses "forming a list of the selected one or more items of information...without including the selected one or more items of information for which the selected further information has not been received." The Office was unable to find written support for this feature in Applicant's specification. Therefore, this feature was not described in a way as to reasonably convey that the inventor was in possession of this feature.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4> As no claims have been amended, this action does not reproduce the body of the rejections for any of the claims. The body of the rejections can be found in previous Office actions, including the non-final rejection, filed 8.4.2006.

5> Claims 18, 19, 22, 23, 26, 33, 35, 37-39 and 44 are rejected under 35 U.S.C § 103(a) as being unpatentable over Blount in view of Slotznick, U.S. Patent No. 6,011,537, in further view of Saksena, U.S Patent No. 6,023,726.

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6> Claim 17 is rejected under 35 U.S.C § 103(a) as being unpatentable over Blount, Slotznick and Saksena, in further view of Deo et al, U.S Patent No. 5,973,612 ["Deo"].

7> Claims 20 and 21 are rejected under 35 U.S.C § 103(a) as being unpatentable over Blount, Slotznick and Saksena, in further view of admitted prior art.

8> Claim 24 is rejected under 35 U.S.C § 103(a) as being unpatentable over Blount, Slotznick, and Saksena, in further view of Lambert et al, U.S Patent No. 6,038,601 ["Lambert"].

9> Claim 27 is rejected under 35 U.S.C § 103(a) as being unpatentable over Blount, Slotznick and Saksena, in further view of Zarom, U.S Patent No. 6,356,529.

10> Claim 30 is rejected under 35 U.S.C § 103(a) as being unpatentable over Blount, in view of Saksena.

11> Claim 40 is rejected under 35 U.S.C § 103(a) as being unpatentable over Saksena.

12> Claims 41 and 42 are rejected under 35 U.S.C § 103(a) as being unpatentable over Blount, Slotznick and Lambert in further view of Horvitz, U.S Patent No. 6,182,133.



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13> Claims 45-48 are rejected under 35 U.S.C § 103(a) as being unpatentable over Blount in view of Horvitz.

14> Claims 18, 19, 22, 23, 26, 33, 35, 37-39 and 44 are rejected under 35 U.S.C § 103(a) as being unpatentable over Blount in view of Slotznick, U.S Patent No. 6,011,537, in further view of Nielsen, U.S Patent No. 5,903,727.

#### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

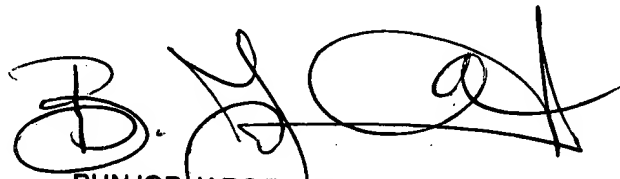
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER